

REMARKS

Claims 1-17 and 35-55 were pending as of the action of July 22, 2010. Amendments to claims 1, 35, and 52-55 are being submitted. No new matter has been added. Support for the amendments can be found throughout the specification, for example, on pages 20-22.

Reconsideration of the action and further examination are respectfully requested in light of the foregoing amendments and the following remarks.

Section 112 Rejections

Claims 1, 35, and 53 were rejected under 35 U.S.C. § 112 as allegedly being indefinite for insufficient antecedent basis. Claims 1, 35, and 53 have been amended to recite “a first electronic document.” Applicant respectfully requests that this rejection be withdrawn.

Section 103 Rejections

Claims 1-12, 14-15, 35-46, 48-49, and 52-53 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2003/0146939 (“Petropoulos”).

Claims 13, 16, 47, and 50 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos in view of U.S. Patent Publication No. 2002/0165767 (“Ogura”).

Claims 17 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos in view of Ogura, and further in view of U.S. Patent Publication No. 2003/0032677 (“Morgenthaler”).

Claim 51 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos in view of Morgenthaler.

Claims 54-55 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Petropoulos in view of U.S. Patent Publication No. 2005/0235203 (“Undasan”). Applicant respectfully traverses these rejections.

Claim 1

Claim 1 as amended recites “including the electronic advertisement in the second electronic document, where the electronic advertisement is included in less than an entire portion of the second electronic document.”

Applicant respectfully submits that the cited portions of Petropoulos do not describe or suggest these features of amended claim 1. The system in Petropoulos provides a page of search results with the capability to show a preview of each search result upon an indication by the user. *See Abstract.* The icon that the user selects to trigger the preview window can be framed within different areas. *See FIG. 5.* The search result preview, once enabled, is shown in a pop-up window. *See FIG. 1.*

Applicant respectfully submits that a search result preview window does not teach or suggest including an electronic advertisement in a second electronic document, where the electronic advertisement is included in less than an entire portion of the second electronic document.

Applicant further respectfully submits that the cited portions of Undasan do not describe or suggest these features of claim 1. The system in Undasan provides preview information of a hyperlink when the user mouses over that hyperlink. *See Abstract.* The user can further preview another document from the first preview window. *See FIG. 2.*

Applicant respectfully submits that a system with two successive preview windows does not teach or suggest including an electronic advertisement in a second electronic document, where the electronic advertisement is included in less than an entire portion of the second electronic document.

Therefore, Applicant respectfully submits that claim 1 is in condition for allowance. Claims 2-17 and 54 depend from claim 1 and are allowable for at least this reason.

Claim 35 is directed to an apparatus configured to perform the steps of “including the electronic advertisement in the second electronic document, where the electronic advertisement is included in less than an entire portion of in the second electronic document.” Applicant respectfully submits that the relied-upon portions of Petropoulos do not teach or suggest these features of claim 35. Applicant respectfully submits that claim 35 is in condition for allowance. Claims 36-51 and 55 depend from claim 35 and are allowable for at least this reason.

Claim 52 is directed to a method to perform the steps of “including the electronic advertisement in the second electronic document, where the electronic advertisement is included in less than an entire portion of the second electronic document.” Applicant respectfully submits

that the relied-upon portions of Petropoulos do not teach or suggest these features of claim 52.

Applicant respectfully submits that claim 52 is in condition for allowance.

Claim 53 is directed to a computer-implemented method to perform the steps of “including the electronic advertisement in the second electronic document, where the electronic advertisement is included in less than an entire portion of the second electronic document.”

Applicant respectfully submits that the relied-upon portions of Petropoulos do not teach or suggest these features of claim 53. Applicant respectfully submits that claim 53 is in condition for allowance.

Interview Summaries

Applicant thanks Examiner Brandenburg for the courtesy of telephonic interviews conducted on September 2, 2010, and September 9, 2010. The rejection of claim 1 under 35 U.S.C. 103(a) was discussed. Applicant agreed to amend claim 1 to further clarify how the electronic advertisement is included in the second electronic document. Examiner Brandenburg indicated that the proposed amendments would distinguish over the art of record, but that further search would be necessary.

Conclusion

For the foregoing reasons, Applicant submits that all the claims are in condition for allowance.

By responding in the foregoing remarks only to particular positions taken by the Examiner, Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, Applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, Applicant's decision to amend or cancel any claim should not be understood as implying that Applicant agrees with any positions taken by the Examiner with respect to that claim or other claims.

The required fees are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: Sept. 14th, 2010

/Michael P. Shepherd/
Michael P. Shepherd
Reg. No. 64,231

Customer No. 26192
Fish & Richardson P.C.
Telephone: (404) 892-5005
Facsimile: (877) 769-7945